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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/572,704	03/17/2006	Toshiharu Iwasaki	Q77856	5365
23373 7590 09/21/2009 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
EXAMINER AUGHENBAUGH, WALTER				
ART UNIT		PAPER NUMBER		
1794				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/572,704

**Applicant(s)**

IWASAKI ET AL.

**Examiner**

WALTER B. AUGHENBAUGH

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF 298)  
Paper No(s)/Mail Date 3/17/06 6/07/06
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Specification***

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because "the present invention provides" (lines 2-3) and "of the present invention" (line 3) are phrases which can be implied, which should be avoided. Furthermore, the language in lines 2-4 does not conform to standard English and must be corrected ("The present invention provides the polypropylene-base molded article of the present invention is a single-layer or multilayer molded article..."). The term "comprising" (line 4) is a legal term which should be avoided.

Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 12, 13 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 1, the precise nature of the composition that Applicant intends to recite cannot be ascertained for the following reasons:

-in line 9, the claim recites “the melt flow rate is in the range of from...”, but it is not clear what the recited melt flow rate is the melt flow rate of: is it (1) the thermoplastic resin composition overall (that is, the blend of components A and B)? (2) of component A only (component A comprises components C and D)? or (3) of component D? Given the language of the claim as it currently stands, it is not clear which of these three the recited melt flow rate is the melt flow rate of. Clarification and/or correction is required. If Applicant intends to recite that the melt flow rate is a melt flow rate of an entity different from the three options listed above, Applicant should identify the entity and amend the claim accordingly.

-that which is recited in lines 10-11 appears to contradict that which is recited in line 8 (or it is at least unclear whether or not lines 10-11 contradict line 8): line 8 does not require that the component D comprise a propylene, but lines 10-11 appear to require that component D comprises 50-85% by mass propylene. Does Applicant intend to require that component D comprise a propylene via the language of lines 10-11 (as the language of line 10-11 suggests), or does Applicant intend propylene to be an optional component of component D (as the language of line 8 suggests)? Furthermore, that which Applicant intends to recite by “the unit originated in the propylene in the copolymer elastomer component (D)” cannot be ascertained. What scope of compositions is intended to be delineated by “the unit originated in the propylene”: this phrase suggests a broader scope of compositions than that delineated by “propylene”. Clarification and/or correction is required.

-in line 12, the claim recites “the xylene-soluble portion...”, and the remainder of the claim (lines 13-27) are directed to “the xylene-soluble portion...”; however, it is not clear what the recited xylene-soluble portion is a xylene-soluble portion of: is it of (1) the thermoplastic resin composition overall (that is, the blend of components A and B)? (2) of component A only (component A comprises components C and D)? or (3) of component D? Given the language of the claim as it currently stands, it is not clear which of these three the recited xylene-soluble portion is a xylene-soluble portion of. Clarification and/or correction is required. If Applicant intends to recite that the xylene-soluble portion is a xylene-soluble portion of an entity different from the three options listed above, Applicant should identify the entity and amend the claim accordingly.

Furthermore, in line 16, it is not clear what the xylene-insoluble portion is a xylene-insoluble portion, for the same reasons provided above in regard to the xylene-soluble portion.

Lines 17-27 discuss a “high propylene content component” and a “low propylene content component”, but it is not clear what these components are a component of for the same reasons provided above in regard to the xylene-soluble portion (thermoplastic resin composition overall, component A, component D, or another entity?).

In regard to claim 12, the language of the claim as it currently stands makes it unclear whether or not Applicant intends the “a multilayer polypropylene-base molded article” (line 2 of claim 12) to correspond to the multilayer polypropylene-base molded article recited in claim 1, or if the “multilayer polypropylene-base molded article” of claim 12 is an additional “multilayer polypropylene-base molded article” that is additional to the multilayer polypropylene-base

molded article recited in claim 1, and that is not required to meet the limitations of claim 1. Note “a” is used immediately before “multilayer polypropylene-base molded article”, not “the” or “said” (this would suggest that it is different from the one recited in claim 1).

In further regard to claim 12, the language of the claim as it currently stands makes it unclear whether or not Applicant intends the “a polypropylene resin composition” to correspond to the polypropylene resin composition (A) recited in claim 1, or if the “a polypropylene resin composition” of claim 12 is an additional “polypropylene resin composition” that is additional to the polypropylene resin composition (A) recited in claim 1, and that is not required to meet the limitations of the polypropylene resin composition (A) of claim 1. Note “a” is used immediately before “polypropylene resin composition”, not “the” or “said” (this would suggest that it is different from the one recited in claim 1).

Claims 13 and 16 are rejected for the same reason that claim 12 is rejected in regard to the recitation “a multilayer polypropylene-base molded article”.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Nohara et al. (EP 0 708 146 A1).

In regard to all claims, Nohara et al. teach a molded article comprising a layer that comprises a composition that corresponds to the claimed composition. See, for example, page 2, line 38-page 3, line 38, page 7, lines 51-53, page 9, lines 44-49, the Examples on pages 10-22 and the claims. In regard to any property that is not specifically taught by Nohara et al., these characteristics would be inherent in the composition because the composition taught by Nohara et al. corresponds to the claimed composition, so the skilled artisan would expect the inherent physical characteristics to be the same, as well, since there is nothing otherwise recited that would lead to a different result. Also note that

[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In *re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977)...

MPEP 2112 I.

In further regard to claims 5-8 and 10, the multilayered article taught by Nohara et al. corresponds to the multilayered article claimed in claims 5-8 and 10 (page 9, lines 41-49 and page 9, lines 65-70). In further regard to claims 6-8, since Nohara et al. teach that the propylene of the invention of Nohara et al. can also be used as the material of the additional layer (page 10, lines 8-9), the multilayered laminates of Nohara et al. having a second layer comprising the propylene of the invention of Nohara et al. corresponds to the laminates recited in claims 6-8.

In regard to claims 11-18, the multilayered article taught by Nohara et al. corresponds to container claimed in claims 11-18.

In further regard to claims 12-17, the multilayered article taught by Nohara et al. corresponds to the multilayered article claimed in claims 12-17 (page 9, lines 41-49 and page 9, lines 65-70). In further regard to claims 13-17, since Nohara et al. teach that the propylene of the invention of Nohara et al. can also be used as the material of the additional layer (page 10, lines 8-9), the multilayered laminates of Nohara et al. having a second layer comprising the propylene of the invention of Nohara et al. corresponds to the laminates recited in claims 13-17.

In further regard to claim 18, the recitation "which is a medical container for housing a medical substance" is an intended use phrase that has been given little patentable weight, since it has been held that a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQd 1647 (1987). This recitation does not positively recite any structural or compositional limitation over those recited in claim 11.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is (571) 272-1488. The examiner can normally be reached on Monday-Thursday from 9:00am to 7:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Walter B Aughenbaugh /

Examiner, Art Unit 1794

9/16/09